

REMARKS/ARGUMENTS

Entry of the foregoing, and reconsideration of the subject application in light of the following remarks is respectfully requested.

Claims 1-17, 19-24 and 33 remain in this application. Claims 18 and 25-32 have been canceled.

Applicants thank Examiners Lu and Wu for their kindness in meeting with Applicants' undersigned representatives at the Patent Office on February 13, 2003.

Before addressing the merits of the Office Action, Applicants respectfully point out that claim 17 as previously submitted, and as currently amended, but for minor differences in overlapping ranges, is identical to claim 1 of U.S. Patent No. 5,824,729 to Matsushita et al. MPEP 2307.02 requires the Group Director to approve any letter rejecting claims of a pending application on grounds applicable to that of an issued patent. Given the near identical language of Applicants' claim 17 and Matsushita's claim 1, the Examiner's rejection of at least claim 17 under 35 U.S.C. § 103 as obvious over Dams (US 4,355,129) in view of Milbert (US 3,821,140), must also be applicable to Matsushita's claim 1. Accordingly, Applicants respectfully request that the Examiner henceforth proceed in accordance with Patent Office procedure and seek approval of the Group Director before any issuing any further Office Actions on the subject Application.

Furthermore, Applicants respectfully submit that the Examiner has erred in her assertion that Applicants' Request filed under 37 C.F.R. § 607 should not yet be considered. 37 C.F.R. § 607(b) provides that when an applicant seeks an interference with a patent, examination shall be conducted with "special dispatch." The Examiner must determine whether any claimed subject matter in the application interferes with the patent, and if interfering subject matter is found an interference will be declared. See 37 C.F.R. § 607(b). Applicants contend that failure to

consider their Rule 607 Request until after examination of the application is complete is in contravention of the special dispatch requirement. Accordingly, Applicants respectfully request that the Examiner consider a Second Request under 37 C.F.R. § 607 submitted herewith.

I. Claim Rejection under 35 U.S.C. § 112

The Patent Office has rejected all claims under 35 U.S.C. § 112, first paragraph as allegedly containing new matter. In particular, the Patent Office has alleged the phrase “wherein said coupling agent (c) is present in an amount effective to act as a surface modifier” in claims 1, 31, and 32 was not provided by Applicants at the time the amendment was filed. Although Applicants respectfully maintain this phrase is supported by the specification as originally filed, Examiners Lu and Wu indicated at the above-referenced interview on February 13, 2003, that this limitation is not necessary for patentability in light of the cited art. Accordingly, the claims have been amended to remove this limitation, and thus overcome the Examiner’s rejection.

The Patent Office has rejected claim 17, stating that the phrase “silane treating agent” is new matter. Applicants respectfully maintain no substantive difference is presented by the term “treating” instead of “coupling.” However, claim 17 has been amended to change the word “treating” to “coupling” to advance the prosecution of the case.

The Patent Office has rejected claims 17 and 19-24 as allegedly failing to support the relative amount of ranges for components (A)-(D). Applicants respectfully traverse this rejection. Support for the relative amount of ranges between components (A) and (B) is found in the specification as originally filed at least at page 6, line 23-25. Support for the relative amount of ranges for component (C) is found at least in claim 1 as originally filed. Despite the ranges of claim 17 being weight parts, while the ranges of claim 1 are percent by weight of the total composition, the weight parts of component (C) in claim 17 fall within the percentage

weight by total composition of claim 1. Support for the relative amount of ranges for component (D) with respect to component (A) is found at least in Examples 1 and 2, and further is commonly known in the art. Accordingly, the ranges claimed by Applicants in claim 17 are supported in the specification as originally filed, and the rejection as to claims 17-30 under 35 U.S.C. § 112, first paragraph should be withdrawn.

II. Claim Rejection under 35 U.S.C. § 102(e)

The Patent Office has rejected claims 1-6, 8-13, 15-17 and 19-24 as allegedly anticipated by Matsushita. As discussed above, Applicants have previously submitted a Request for an Interference Pursuant to 37 C.F.R. § 607 accompanied by an affidavit antedating Matsushita as a reference, in accordance with 37 C.F.R. § 608. The interference request has not yet been considered by the Patent Office. A Second Request for an Interference Pursuant to 37 C.F.R. § 607 is submitted herewith to reflect changes to the claims made by this Amendment, and accordingly, the proposed counts. Although Applicants urge otherwise, the Examiner currently indicates she will not consider Applicants' Request for an Interference until all other issues relating to patentability of this invention have been resolved. When Applicant's request is considered, the Rule 608 affidavit will remove Matsushita as a reference.

III. Claim Rejection under 35 U.S.C. § 103(a)

The Patent Office has rejected claims 7, 12, and 14 as being obvious over Matsushita. As discussed above, Applicants' respectfully traverse as Matsushita is not a proper reference and should be removed upon the Patent Office's consideration of Applicants' Request for an Interference and Rule 608 affidavit.

The Patent Office has also rejected claims 1-17 and 19-24 as obvious over Dams in view of Milbert. For the reasons set forth below, Applicants respectfully traverse the rejection.

As disclosed in detail in the specification of the present application, the present invention provides a heat-cured silicone rubber composition suitable for outdoor high voltage insulator applications. The composition further includes an anti-tracking agent, such as aluminum trihydrate (ATH), and a coupling agent. The coupling agent acts as a surface modifier for the anti-tracking agent and as a cross-linking agent between the anti-tracking agent and the polysiloxane of silicone rubber composition. The coupling agent renders the anti-tracking agent hydrophobic, and enhances its dispersability. Further, the anti-tracking agent improves arc resistance and the flame retardancy of the composition.

Dams discloses pigmented organopolysiloxane elastomer-forming compositions which in the cured state have improved color stability when exposed to a corona discharge. Dams provides a composition which includes:

- (A) a polydiorganosiloxane convertible to the solid elastic state,
- (B) a filler,
- (C) an organic peroxide curing agent, and
- (D) from 0.01 to 10 parts by weight per 100 parts by weight of (A) of pigment which is an inorganic calcined complex containing Co and Al.

Applicants submit that Dams is directed toward a composition with a utility quite separate from that of Applicants' invention (i.e., increased color stability versus improved tracking resistance and hydrophobicity). Accordingly, one in the art would not look to Dams as a reference. Further, for an artisan to select from all of the options presented by Dams and arrive at a composition close to Applicants' invention would involve such a circuitous route of random experimentation that it could be achieved only by happenstance. Happenstance is insufficient to form a basis for prima facie obviousness. See *In re Fine*, 5 U.S.P.Q.2d. 1596, 1600 (Fed. Cir. 1988).

Examples
used
everything
except

The present invention differs from that of the Dams disclosure, at the very least, in that:

- Dams does not require an anti-tracking agent (Claims 1 and 17).
- Dams does not require a reinforcing filler (Claim 1).
- Dams does not require that the surface of the filler be modified (Claim 1).
- If the surface of the filler is modified, Dams does not require that the modifier be a coupling agent (Claim 1).
- Dams does not require that the coupling agent coat the filler in situ (Claim 1).
- Dams does not teach that the surface of the anti-tracking agent is modified (Claims 1 and 17).
- Dams does not teach modifying the surface of the anti-tracking agent with a silane coupling agent (Claim 17).
- Dams does not address in any fashion the amount of coupling agent to modify either the surface of the filler or the anti-tracking agent (Claims 1 and 17).

Regarding this last point in particular, even assuming that an artisan stumbled across every conceivable choice in Dams which might possibly lead to Applicants' invention, Dams still does not disclose, teach, or suggest an appropriate amount of coupling agent which should be added. The Examiner has failed to present any evidence which might suggest how much coupling agent should be added to treat the Dams filler. Consequently, Dams does not teach the amount which would be needed to coat the anti-tracking agent which is only an optional

the range is broad,

component in the first place. As the Federal Circuit has held:

To imbue one of ordinary skill in the art knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

In re Fine at , U.S.P.Q.2d at 1600, quoting *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

Further, with regard to claim 1 in particular, Dams does not disclose a processing fluid which is a polysiloxane oil. Although Dams does disclose certain polysiloxanes, nowhere does it disclose, teach or suggest that these polysiloxanes are oils, as opposed to waxes or gums. Dams does not discuss polysiloxane rheology except in describing the base polysiloxane which, unlike the Applicants' invention and as the Examiner has recognized, can be either a gum or a high viscosity liquid. As Dams does not disclose a processing fluid, it naturally follows that Dams does not teach that the processing fluid enhances dispersability of the anti-tracking agent within the composition, the anti-tracking agent itself being an optional component.

In sum, Dams completely fails to capture the fundamental concept of Applicants' invention: coating an antitracking agent, such as ATH, with a coupling agent in order to obtain an high voltage insulator silicone composition for electrical insulation that is resistant to arcing and has increased hydrophobicity.

Applicants further respectfully submit that the Examiner's citation to Milbert, alone or in combination with Dams, adds nothing to the Examiner's case against Applicants. Milbert discloses a polysiloxane composition curable to a fire resistant elastomer which comprises an organopolysiloxane rubber, an inorganic filler, organic peroxide, and an additive of platinum, rare earth metal oxide, or rare earth metal hydroxide.

Reference should be attached individually
Milbert is inapposite as a reference as nowhere does it disclose, teach, or suggest using an anti-tracking agent, such as ATH. Further, like Dams, Milbert teaches that a filler may be added which may or may not be treated to modify its surface. Also like Dams, Milbert does not disclose, teach, or suggest the manner in which this should be done. As Milbert does not teach an anti-tracking agent at all, Milbert can certainly not teach the amount of coupling agent needed to modify the anti-tracking agent's surface.


For at least these reasons, Applicants submit that claims 1-17, 19-24 and 33 are in condition for allowance and request that the Patent Office withdraw its rejection and declare an interference with Matsushita and U.S. Patent No. 6,090,879.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below to conduct an interview in an effort to expedite prosecution in connection with the present application. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-0206.

Respectfully submitted,

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